

REMARKS

Claims 23-74 are currently pending in the application. No claims are currently amended. No new matter has been added.

I. Rejections of Claims under 35 U.S.C. § 101

Claims 56-68 and 73-74 stand rejected under 35 U.S.C. 101 as allegedly being directed to non-statutory subject matter. More particularly, the final Office action alleges that “these system claims are rejected as non-statutory for failing to disclose any hardware. It is noted that the claimed processor could be interpreted as a software element which does processing and therefore the claim is non-statutory for not disclosing hardware.” Item #3, p. 2, December 09, 2008 final Office action. Applicants respectfully disagree.

Applicants also respectfully submit that 35 U.S.C. § 112, sixth paragraph, mandates that “such claims shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof” “without the recital of structure, material, or acts in support thereof”. The Federal Circuit in *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), specifically stated that “[p]er our holding, the ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the **PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.**” (Emphasis added.) As such, Applicants respectfully submit that the basis for rejection of claims 22, 26, and 28 may be improper and thus respectfully request withdrawal of rejections and reconsideration of these claims as mandated by 35 U.S.C. § 112, six paragraph.

Therefore, Applicants respectfully submit that 35 U.S.C. § 112, sixth paragraph, requires that the broadest reasonable interpretation of the means-plus-function limitation the examiner may give is statutorily mandated. Also, the final Office action's interpretation of processor to constitute only software means clearly and erroneously neglects the hardware / structure that is explicitly disclosed in the specification of the instant application.

As such, Applicants respectfully request withdrawal of the rejections and reconsideration of claims 56-68 and 73-74 for at least the foregoing reasons.

II. Claim Rejections - 35 USC § 102(e)

Claims 23-68 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2004/0066529 by Wu et al. (hereinafter Wu.)

Without acquiescence in the cited basis for rejections or prejudice to pursue the original claims in a related application, claim 23 is currently amended to clarify the subject matter and recites at least the following limitations. Claims 43 and 56 also recite similar limitations.

another collection partition is removed from the computer-readable memory where there is insufficient space for loading the collection partition; and
(emphasis added.)

Applicants respectfully submit that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described” MPEP § 2131 (emphasis added.) MPEP further mandates that “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim” and that “[t]he elements must be arranged as required by the claim” MPEP 2131 (emphasis added.)

A. The final Office action cites to ¶ [0044], ll. 1-5 of Wu and purports that the cited passages of Wu disclose the above claimed limitations. Applicants respectfully disagree.

(a) ¶ [0044] is reproduced below for reference.

[0044] To "delete" data from the RAM 103, on the other hand, refers to permanent erasure of data from the RAM 103. An example of such permanently erased data may be display content data of a document element having been incorporated into a printed page, except data which will be utilized later in other pages.

It can be clearly seen from the above recitation that ¶ [0044] merely discloses the following. Firstly, ¶ [0044] defines what Wu defines deleting data from the RAM as referring to the "permanent erasure of data from the RAM". ¶ [0044], ll. 1-3. Secondly, ¶ [0044] discloses an example of such permanent erasure of data from the RAM. In ¶ [0044], ll. 3-6, Wu discloses the scenario where some display content data other than the data which will be utilized later in other pages have been incorporated into a printed page, these display content data may be permanently erased from the RAM 103.

That is, ¶ [0044] merely suggests that the content display data which have been incorporated into a printed page and will not be utilized later may be permanently erased from the RAM. Nonetheless, Applicants respectfully submit that these passages never disclose the claimed limitation of "another collection partition is removed from the computer-readable memory where there is insufficient space for loading the collection partition".

(b) The final Office action further explains in the Response to Arguments section that Wu discloses the above claimed limitations because "Wu discloses deleting content data of a document element using an LRU scheme" Item #10, p. 14, December 09, 2008 final Office action (citation omitted.) Applicants respectfully disagree.

In ¶ [0045], Wu discloses that Wu's approach "differs from data deletion management according to the Least Recently Used, or LRU, algorithm". Wu's approach unloads "data capable of being deleted and reloaded without delaying the printing". ¶ [0045], ll. 2-6. On the other hand, LRU is commonly understood as discarding the least recently used item first. Nonetheless, neither the LRU nor Wu's approach even remotely suggests at least the limitation of "another collection partition is removed . . . where there is insufficient space for loading the collection partition".

Therefore, Applicants respectfully submit that Wu fails to disclose each and every element and fails to show an identical invention as required by the claims and thus may not be used to preclude the patentability of claims 23-68 under 35 U.S.C. § 102(e) for at least the foregoing reasons.

III. Claim Rejections - 35 USC § 103(a)

Claims 69, 71, and 73 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wu in view of U.S. Patent No. 6,081,262 issued to Gill et al. (hereinafter Gill.) Applicants respectfully traverse.

The final Office action concedes that Wu does not disclose the claimed limitations of claims 69, 71, and 73 yet cites to Gill and alleges that Gill discloses these additional limitations of claims 69, 71, and 73. Applicants respectfully submit that regardless of whether or not Gill discloses these additional limitations, claims 69, 71, and 73 are believed to be allowable over Wu and Gill because of their dependency from the base independent claims 23, 43, and 56 and further because of the final Office action does not rely on Gill in supporting the basis for rejection of claims 23, 43, and 56.

IV. Claim Rejections - 35 USC § 103(a)

Claims 70, 72, and 74 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wu in view of Gill and further in view of U.S. Patent No. 5,446,854 issued to Khalidi et al. (hereinafter Khalidi.) Applicants respectfully traverse.

The final Office action concedes that Wu and Gill do not disclose the claimed limitations of claims 70, 72, and 74 yet cites to Khalidi and alleges that Khalidi discloses these additional limitations of claims 70, 72, and 74. Applicants respectfully submit that regardless of whether or not Gill discloses these additional limitations, claims 70, 72, and 74 are believed to be allowable over Wu and Gill because of their indirect dependency from the base independent claims 23, 43, and 56 and further because of the final Office action does not rely on Gill in supporting the basis for rejection of claims 23, 43, and 56.

CONCLUSION

Based on the foregoing, all claims are believed allowable, and an allowance of the claims is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below.

Applicant(s) hereby explicitly retracts and rescinds any and all of the arguments and disclaimers presented to distinguish the prior art of record during the prosecution of all parent and related application(s)/patent(s), and respectfully requests that the Examiner re-visit the prior art that such arguments and disclaimers were made to avoid.

The Commissioner is authorized to charge any fees due in connection with the filing of this document to Vista IP Law Group's Deposit Account No. 50-1105, referencing billing number 7035722001. The Commissioner is authorized to credit any overpayment or to charge any underpayment to Vista IP Law Group's Deposit Account No. 50-1105, referencing billing number 7035722001.

Respectfully submitted,

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